

c14 (a) a screw rotatably connected to the container, the screw having a portion disposed within the molded stick composition, the screw being rotatable in a first direction to advance the molded stick composition with respect to the walls, and the screw being rotatable in a second direction to retract the molded stick composition with respect to the walls.

REMARKSSTATUS OF THE CLAIMS:

Claims 55 and 56 have been added.

Claims 1-13 and 51-56 are pending in the application.

Claims 1, 12, 51 and 53 have been amended.

The amendments to claims 1 and 12 and new claims 55 and 56 do not add new matter.

TELEPHONE INTERVIEW:

The Applicant would like to thank Examiner Walczak for all of the courtesies extended in the telephone interview held on June 6, 2002 to Gene Szczecina and Louis DelJuidice. The Applicant would throughly like to thank the Examiner for the agreement that the amendment that claims 1 and 12 and to the specification as made above distinguishing the present invention over the rejections of record.

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**STATUS OF THE SPECIFICATION:**

The specification stands objected to for failing to provide proper antecedent basis for the claimed subject matter. The Examiner states that the subject matter in new claims 51-54 does not have antecedent basis in the specification. Additionally, the Examiner states that in regard to claims 1 and 12, the recitation of the interior wall being substantially smooth does not have antecedent basis in the specification.

The Applicant respectfully points out that portions of the specification have been amended to correct minor typographical errors. Additionally, portions of the specification have been amended to include the recitation of the interior wall being substantially smooth. Support for this amendment is found, for example, in Figs. 3(d), 3(c), 3(d), 7(b) and 8(a). These figures clearly illustrate the interior walls of the container being substantially smooth. Thus, the claimed structure was present in the drawings at the time of filing, and the current amendments add that language to the specification. Thus, the Applicant respectfully requests that the above rejection be withdrawn.

**CLAIMS REJECTIONS - 35 U.S.C. § 112**

Claims 1-13 and 51-54 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art, at the time the

application was filed, that they had possession of the claimed invention. In particular, the Examiner states that the limitation "and retractable" is considered to be new matter and must be deleted from the claims.

The Applicant respectfully traverses this rejection by pointing out that the term "and retractable" is not new matter. The Examiner is directed to Figs. 1(c), 3(a) and 3(c), particularly the illustration of container screw 105. Also, page 20, lines 13-14, prior to amendment, disclosed "the container screw 105, when rotated, advances the composition through the open end of the container 100". The Applicant respectfully maintains that use of a screw to advance *and retract* a lip composition product is disclosed. The Figures, particularly Fig. 3(c), clearly illustrate a center screw, and even the threading of the screw is shown in contact with the multi-composition stick product. Thus, the feature that the multi-composition stick product is additionally retractable via a screw was illustrated in the Figures and was well known in the art at the time this application was filed. Applicant, also appreciatively acknowledges that during the course of the telephone interview, the Examiner agreed that based on these facts, the term "and retractable" is not new matter. Thus, the addition to the claims and to the specification reciting the feature that the multi-composition stick product is retractable is not new matter. Thus, the Applicant respectfully requests that the above rejection be withdrawn.

Claims 51 and 53 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention. In regard to claims 51 and 53, the Examiner requested that antecedent basis for "the surface area of the first composition" and "the surface area of the second composition" should be provided.

The Applicant respectfully traverses the above rejection by stating that claims 51 and 53 have been amended to provide proper antecedent basis. Thus, Applicant respectfully requests that the above rejection be withdrawn.

**REJECTIONS UNDER 35 USC § 103(a)**

Claims 1 -13 and 51-54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,061,084 to Tibbitts in view of U.S. Patent No. 3,129,930 to Prince. The Examiner states in regard to claims 1, 3, 4, 5 and 12, that Tibbitts discloses a lipstick product 20 comprised of a container 12, having smooth interior walls, wherein the product is in sliding contact with the walls and is advanceable and retractable in the container. However, the Examiner admits that Tibbitts does not disclose the stick being formed from two different compositions. The Examiner states that Prince discloses another lipstick product wherein the product is formed from a first composition 14 and a second composition 11, which differ in color to form a predetermined multi-color image in order to enable a user to easily apply two different colors of lipstick. Thus, the Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include two-composition lip-stick into the Tibbitts' container in order to enable a user to easily

apply a lipstick having two different colors based on the teachings of Prince.

In regards to claim 2, the Examiner states that the interior and exterior surfaces of the Tibbitts container are different. In regard to claim 6, the Examiner states that the image is a circle and for claim 7, the Examiner states that each cross-section of the stick contains the same image. In regards to claim 8, the Examiner states that the stick is used for application and for claim 9, the Examiner states that the composition is a lip-stick. In regard to claim 10, the Examiner states that the composition includes a pharmaceutically acceptable vehicle and for claim 11, the Examiner states that the composition comprises a colorant. The Examiner states for claim 13, the Prince stick composition is any preparation to be applied to the surface of a human body for cleaning and conditioning the skin. Thus, the Examiner contends that since lip balm is applied to human skin and used for conditioning the lip, Prince anticipates the use of lip balm. In regards to claims 51 and 53, the Examiner states that the surface area of the first composition 14 is substantially different than the surface area of the second composition 11 and in regards to claims 52 and 54, the Examiner states the wall thickness of the first composition 14 is substantially different than the wall thickness of the second composition 11, the thickness of composition 14 is greater than the thickness of composition 11 as composition 11 narrows at the top. Further, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the two compositions in the Prince reference can be designed to have any suitable thicknesses, depending

on the needs and desires of the user, without effecting the overall operation of the device.

The Applicant respectfully traverses the above rejections by pointing-out that the presently claimed invention has been further amended to recite the limitation that the walls of the container proximate to the molded stick composition are rigid throughout. The Applicant states that Tibbitts solely teaches a container in which half of the container is rigid and the other half is crushable. See Figs. 2 and 3. This structure is clearly disclosed in Tibbitts col. 2, lines 13-17 as "a thin crushable or inwardly foldable tubular container 18 [that] is homogenous and continuously molded to the receiving end of the rigid tube 12. The crushable tube 18 acts in cooperation with the rigid tube 12 to house a cosmetic stick 20." The rigidity of the container in Applicant's invention is illustrated in a number of figures that show the container cut away or in cross section. Figures 2b, 2g, 2k, 2p, 3b, 3c, 3d, 44, 6a, and 7b, all indicate that the material of the canister is metal, per the symbol classification at M.P.E.P. §608.02. Fig. 1c, also show the container being made of a plastic material, which Applicant maintains is preferably rigid. Thus, Tibbitts teaches away from a container tube that is substantially rigid throughout. Also, Applicant maintains that the crushable tube portion of Tibbitts must be at least half of the portion of the entire length of the container. Tibbitts states that crushable tube 18 is used to discharge cosmetic stick 20. Thus, the only way the entire stick could be discharged is if crushable portion 18 can move at least half the length of cosmetic stick 20, if not

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more. Thus, the Applicant submits, and the Examiner agreed during the telephone interview, that claims 1 and 12 are patentable over Tibbitts and withdrawal of the claim rejection on these grounds is respectfully requested. Additionally, claims 2-11 and 13 depend upon claims 1 and 12 and thus if the elements of claims 1 and 12 are allowable, then all of the dependent claims are allowable.

Applicant respectfully traverses the rejections to claims 52 and 54 by stating that claims 52 and 54 state the limitation that the wall thickness of the first composition is substantially different than the wall thickness of the second composition. This is in opposite to the invention and teachings in Prince. In col. 1, lines 12-19 and 40-48, Prince states that the crux of his invention is to produce a two-tone lipstick that will give natural gradation and coloration to the lips. Prince recites the benefit that the cosmetic imparts of the difference in coloration where the lips meet as opposed to the upper surface of the lips. Thus, both compositions would need to be of substantially the same wall thicknesses to achieve such coloration patterns. Additionally, in col. 2, lines 6-7 and lines 44-46, Prince first states that the walls of the cosmetic rod 11 should have a uniform thickness all the way around and in claim 1 states that the wall thickness of the hollow rod is substantially equal to one half the diameter of the hollow in the rod. The dimensioning taught by Prince will create equal wall thicknesses between the two compositions. Additionally, the Applicant respectfully directs the Examiner to lines 44-47 where Prince recites "as will be seen from inspection of FIGURE 2, the sum of the radial widths of the opposite


sections of the rod are substantially equal to the diameter of the core." Further on Prince clearly states that the two compositions need to be substantially equal and that the taper is only on the very top of the stick. Thus, it is the Applicant's contention that even though in col. 1, lines 67-68, Prince states the cosmetic rod may be slightly tapered toward the top, Prince actually teaches away from a cosmetic rod of unequal wall thickness.

### CONCLUSION

Therefore, in view of the above amendments and remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

  
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ATTORNEY DOCKET NO.: 0630/0G528-US0

DATE: June 12, 2002

**TELECOPIER TRANSMISSION COVER SHEET**

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TO: **United States Patent and Trademark Office**

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EXAMINER: Walczak

**JUN 12 2002**

ART UNIT: 3751

**GROUP 3700**

FROM: Louis DeJuidice

PAPER(S) BEING TRANSMITTED: Response to Official Action dated March 26, 2002 (16 pp)

NO. OF PAGES (INCLUDING COVER SHEET): 17

COMMENTS:

**CERTIFICATION OF FACSIMILE TRANSMISSION**

Serial No.: 09/584,640

Filed: May 31, 2000

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PATENT TRADEMARK OFFICE

Docket No: 0630/0G528

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: J. LOOK

Serial No.: 09/584,640

Art Unit: 3751

Confirmation No.: 4278

Filed: MAY 31, 2000

Examiner: D. WALCZAK

For: MULTI-COMPOSITION STICK PRODUCT AND A PROCESS AND SYSTEM FOR  
MANUFACTURING THE SAME

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**MARK-UP TO ACCOMPANY  
RESPONSE TO OFFICIAL ACTION**

Hon. Commissioner of  
Patents and Trademarks  
Washington, DC 20231

June 12, 2002

Sir:

IN THE SPECIFICATION:

Please amend the paragraph from page 1, lines 3-7 to read as follows:

The present invention relates to a multi-composition stick product

comprising a molded stick composition, such as a lip balm, sun screen, deodorant, or glue stick, provided in a container which serves as the mold during manufacture and from which the composition may be [advanced or ejected] advanced/ejected and retracted. The invention also relates to a process and system for manufacturing the stick product.

Please amend the paragraph from page 3, lines 12-17 to read as follows:

The present invention provides a multi-composition stick product comprising a container and a molded stick composition disposed so as to contact the walls of the container and be advanceable and retractable in the container. The stick composition comprises a first composition and a second composition. The first and second compositions differ in at least one component, *i.e.*, the first or second composition contains a component which is not contained in the other composition, and are arranged in a predetermined non-random pattern that is reproducible.

Please amend the paragraph from page 4, lines 3-10 to read as follows:

According to a special aspect of this invention, a stick product is provided comprising a container and a molded stick composition disposed so as to contact the walls of the container and be advanceable and retractable in the container. The container confers a desired shape or design to the stick composition and the stick product. At least a portion of the outer and/or inner contour of the container is non-

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circular. For example, the outer and inner contours of the container may be heart shaped. Alternatively, the outer contour of the container may be heart shaped while the inner contour is circular or vice versa. In this embodiment, the stick composition may have only one phase (homogeneous) or two or more distinct phases.

Please amend the paragraph from page 4, lines 28-29 to read as follows:

Figure 1d is a perspective view of a [multi-composition] multi-composition stick product advanced from an exemplary container having the same inner and outer heart shaped contour;

Please amend the paragraph from page 5, lines 1-3 to read as follows:

Figure 1e is a perspective view of a [multi-composition] multi-composition stick product advanced from an exemplary container having a cylindrical outer contour and a heart shaped inner contour;

Please amend the paragraph from page 6, lines 6-14 to read as follows:

In the application the following terms are defined. The term "stick product" is defined as a product comprising a container and a stick composition, where the stick composition is: (a) manufactured directly in the container in which it is sold, so that the container also serves as a mold during the casting process, whereby the composition is in contact with the side walls of the container, and (b) [advanced or

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ejected] advanced/ejected and retracted, such as by mechanical rotation or mechanical force without rotation, through an open end of the container. The side walls may be substantially smooth to allow the composition to be freely advanced and retracted. The term "stick composition" is defined as a malleable, semi-solid composition that is sufficiently solid so as to substantially retain its shape [advanced or ejected] advanced/ejected and retracted from an open end of the container, while capable of leaving a desired residue when applied by swiping.

Please amend the paragraph starting on page 6, lines 20-27 to read as follows:

Figure 1a is a perspective view of an example multi-composition stick product 10 advanced in the container. The multi-composition stick product 10 comprises a container 12 and a molded stick composition 14 disposed so as to contact the walls of the container and be advanceable and retractable in the container. The stick composition in Figure 1a comprises a first composition and a second composition. It is, however, within the intended scope of the invention for the stick composition to comprise more than two compositions. The first and second compositions are preferably chemically similar materials. In a preferred embodiment, the top surface 16 of the stick composition 14 is substantially planar.

Please amend the paragraph from page 11, lines 1-4 to read as follows:

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The stick composition may be a composition intended for topical application to a person, such as a lip balm, lipstick, lip gloss, deodorant, or sunscreen, or other composition, such as a glue stick. The stick composition is sufficiently solid to substantially retain its shape when [advanced or ejected] advanced/ejected and retracted from the container.

Please amend the paragraph from page 20, lines 5-19 to read as follows:

By way of example, the systems and method for manufacturing the multi-composition stick product in accordance with the present invention will now be described in detail for a specific embodiment of a multi-composition stick product wherein the image is a heart. The heart shaped image in Figures 3a-3d is different than that shown in Figures 1a-1d in that the sides are curved instead of straight. An example nozzle fill system in accordance with a first embodiment of the present invention, is shown in Figures 3a-3d, for filling a single container. The nozzle fill system includes a container or housing 100 and one or more filling nozzles 110. Container 100 preferably has a container screw 105 projecting upwards from its bottom and a lip 107. The container screw 105, when rotated, advances the composition through the open end of the container 100 or retracts the composition back into the container 100. Alternatively, a container shaft projecting from a false bottom may be placed in the bottom of the container, whereby a mechanical force imposed on the false bottom advances the stick composition from the open end of the

container or retracts the composition back into the container 100. The use of a container shaft or container screw may be eliminated altogether, whereby the stick composition is advanced or retracted through the open end of the container and back down by imposing a force on a false bottom of the container.

**IN THE CLAIMS:**

1. (Thrice Amended) A multi-composition stick product, comprising:

(a) a container having walls, an exterior contour, and an interior contour, said interior contour being substantially smooth; and

(b) a molded stick composition disposed so as to be in sliding contact with the walls of the container and be advanceable and retractable in the container, wherein all of the walls of the container proximate to said molded stick composition are rigid throughout, the stick composition comprising:

(i) a first composition; and

(ii) a second composition;

wherein the first and second compositions differ by at least one component and the compositions are arranged in a predetermined non-random pattern that is reproducible.

12. (Thrice Amended) A multi-color stick product, comprising:

(a) a container having walls, said walls being substantially smooth; and

(b) a molded multi-color stick composition disposed so as to be in sliding

contact with the walls of the container and be advanceable and retractable in the container, wherein all of the walls of the container proximate to said molded stick composition are rigid throughout, the stick composition comprising:

- (i) a first composition; and
- (ii) a second composition;

wherein the first and second compositions differ in color and are arranged in a predetermined non-random image that is reproducible.

51. (Amended) The multi-composition stick product in accordance with claim 6, wherein [the] a surface area of the second composition is substantially different than the surface area of the first composition.

53. (Amended) The multi-composition stick product in accordance with claim 6, wherein: the first composition has a predetermined wall thickness;  
[the] a second composition has a predetermined wall thickness; and  
the first composition wall thickness is substantially different than  
the second composition wall thickness.

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